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applying to *skin \* \* \**.” Since the method was for treating blemished skin or acne, it stands to reason that persons skilled in the art would understand that the skin was blemished or acned. However, in order to make explicit what was implicit claim 10 was amended in the amendment dated February 8, 2002, to recite “A method of treating blemished skin or acne comprising topically applying to *blemished or acned* skin.”

The other changes to claim 10 were mainly editorial. In short, none of the changes made to claim 10 materially changed the scope thereof in a manner that would have necessitated the new prior art rejections.

In view of the foregoing, Applicants submit that the final rejection is premature. Accordingly, Applicants respectfully request that the Examiner reconsider and withdraw the finality of the Office Action.

Turning to the substantive issues, claims 10-12, 14-18 and 20-27 were rejected under 35 USC § 103(a) as being obvious over the combination of Bimczok et al. (“Bimczok”), U.S. Patent No. 5,961,999, in view of Traupe et al. (“Traupe”), U.S. Patent No. 5,759,584. In response, Applicants submit that the combination of Bimczok and Traupe does not make out a *prima facie* case of obviousness. Therefore, Applicants respectfully request that the Examiner reconsider and withdraw this rejection.

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Applicants point out that *Manual of Patent Examining Procedure* ("MPEP") § 2143 provides:

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claims limitations. [Italics in original and underlining added.]"

Further, MPEP § 2142 points out that:

"The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness. [Again, italics in original and underlining added.]"

Beginning with Traupe, this is the only cited references which pertains to the treatment of blemished and acned skin. However, this reference expressly requires a special mixture of wool wax acids and monoglycerol monocarboxylic acid monoesters.

The Examiner points out that Traupe teaches that  $\alpha$ -hydroxycarboxylic acids are a "main" constituent of wool wax acids. However, Traupe discloses a large number of such "main" constituent wool wax acids at columns 1-2 therein, and the  $\alpha$ -hydroxycarboxylic acids are only

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one of many "main" constituents.

More importantly, Traupe does not anywhere teach or suggest that the  $\alpha$ -hydroxycarboxylic acids are "the" main constituent which is responsible for the activity shown by the compositions against blemished or acned skin. Logically, the activity could be due to one, some or all of the "main" constituents, or perhaps even a "minor" constituent since Traupe seems to cast "main" in the context of abundance. What is ultimately important, however, is that Traupe does not anywhere teach or suggest that the  $\alpha$ -hydroxycarboxylic acids are "the" main constituent which is responsible for the activity shown by the compositions against blemished or acned skin.

In fact, Traupe arguably suggests otherwise. At column 2, lines 59-64, Traupe appears to teach that raw wool wax acids contain about 30% by weight of  $\alpha$ -hydroxycarboxylic acids. Thus, the bulk of the wool wax acids is a combination of some other material. There is just as much reason to believe that the activity comes from this other material as there is to believe it comes from the  $\alpha$ -hydroxycarboxylic acid. Perhaps even more so since Traupe's preferred embodiment, which is discussed at column 2, line 65, continuing over to column 3, line 4, is a distilled wool wax acid, wherein the amount of  $\alpha$ -hydroxycarboxylic acids has dropped to 22-27%. That the distilled product, having a lower content of  $\alpha$ -hydroxycarboxylic acids, is better than the raw product, having a higher content of  $\alpha$ -hydroxycarboxylic acids, could reasonably be taken as an indication that the activity may not, in fact, be due to the  $\alpha$ -hydroxycarboxylic acids.

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Certainly, a person having ordinary skill in the art, given Traupe, is not left with the understanding that  $\alpha$ -hydroxycarboxylic acids per se would reasonably be expected to be active against blemished or acned skin. In the absence of such expectation, Applicants submit that the combination of Bimczok and Traupe could not possibly have rendered the present invention *prima facie* obvious to such persons.

Bimczok teaches a method for treating wrinkles, which, contrary to the Examiner's reference to a standard dictionary, would have been viewed by persons skilled in the pertinent art to be different from blemishes. In any case, Bimczok's composition does not contain wool wax acids. Consequently, a person having ordinary skill in the art would not have been reasonable to expect that Bimczok's compositions, merely because they contain  $\alpha$ -hydroxycarboxylic acids, would be successful treatments for blemished or acned skin. Again, although Traupe discloses that wool wax acids contain  $\alpha$ -hydroxycarboxylic acids, Traupe also teaches that wool wax acids contain many other substances. Most importantly, Traupe does not teach that the  $\alpha$ -hydroxycarboxylic acids are "the" active component. Consequently, on this record, there is no reason to expect that  $\alpha$ -hydroxycarboxylic acids would have been active against blemished or acned skin.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection. An early notice that this rejection has been reconsidered

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and withdrawn is earnestly solicited.

Claims 10-12, 14-18 and 20-27 were rejected under 35 USC § 103(a) as being obvious over Muller et al. ("Muller"), U.S. Patent No. 6,248,338, in view of Traupe. In response, Applicants respectfully request that the Examiner reconsider and withdraw this rejection as well since it suffers the same defects as the previous rejection. The Examiner admits that Muller only teaches the addition of  $\alpha$ -hydroxycarboxylic acids as *pH regulators*. Thus, the Examiner also concedes that Muller does not teach or suggest that  $\alpha$ -hydroxycarboxylic acids have any activity against blemished or acned skin. Such teaching or suggestion must come from Traupe, but, as discussed above, Traupe does not convey such teaching or suggestion. Consequently, the combination of Muller and Traupe also would not have rendered the present invention *prima facie* obvious.

In view of the foregoing, Applicants submit that the Examiner would be fully justified to reconsider and withdraw this rejection as well. An early notice that this rejection also has been reconsidered and withdrawn is earnestly solicited.

Applicants believe that the foregoing constitutes a bona fide response to all outstanding objections and rejections.

Applicants also believe that this application is in condition for immediate allowance.

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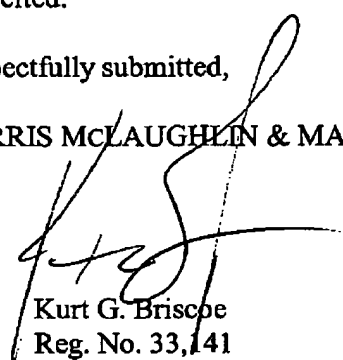
However, should any issue(s) of a minor nature remain, the Examiner is respectfully requested to telephone the undersigned at telephone number (212) 808-0700 so that the issue(s) might be promptly resolved.

Early and favorable action is earnestly solicited.

Respectfully submitted,

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By



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CERTIFICATE OF FACSIMILE TRANSMISSION

I hereby certify that the foregoing Amendment under 37 CFR § 1.116 (9 pages total) is being facsimile transmitted to the United States Patent and Trademark Office on the date indicated below:

Date: June 27, 2002

By

  
Kurt G. Briscoe